

## **REMARKS**

As a preliminary matter, Applicant thanks the Examiner for vacating the previous Office Action that contained erroneous information.

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Utsunomiya (U.S. 6,072,662). Applicant respectfully traverses this rejection because the cited reference does not disclose (or suggest) a recessed portion in the disk-facing surface, as in claim 1 of the present invention, as amended.

The inclusion of Fig. 7 of Utsunomiya in the present Office Action clearly establishes the differences between Utsunomiya's head slider and the present invention. As labeled by the Examiner (page 3), the Examiner is interpreting the rail portions 12 and 13 to be analogous to *both* the disk-facing surface and the air bearing surface of the present invention. This interpretation, however, is unreasonable in light of both the present Specification, as well as Utsunomiya's own disclosure. The "groove" cited by the Examiner from Utsunomiya appears between the rails 12, 13, and above the air film bearing surface 101. Fig. 6b of Utsunomiya, however, unambiguously illustrates that there is no recessed portion or guide groove whatsoever in the surface 101. The outstanding rejection is therefore contradicted by both the Utsunomiya reference itself, as well as the present disclosure.

Nevertheless, although no further amendment to the claims is necessary for the reasons discussed above, Applicant has amended claim 1 further herein only for the purposes of expediting prosecution. Specifically, independent claim 1 of the present invention now more clearly features that the disk-facing surface of the present invention

has both an air bearing surface that is raised from the disk-facing surface and also a portion that is recessed from the disk-facing surface. Even the incorrect interpretation of Utsunomiya, discussed above, cannot read upon this clarifying language. If the Examiner interprets the surface 101 to be equivalent to the disk-facing surface of the present invention, Utsunomiya clearly shows that there is no recessed portion. If the Examiner alternatively interprets the rails 12, 13 to be analogous to the disk-facing surface of the present invention, then Utsunomiya clearly shows that there is no raised air bearing surface. Accordingly, under either potential interpretation of the Utsunomiya reference, the Section 102 rejection of claims 1-6 should be withdrawn.

Claims 7 and 9-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Utsunomiya in view of Nakano (U.S. 6,801,399). Applicant respectfully traverses this rejection for at least the reasons discussed above in traversing the rejection of claim 1 based on Utsunomiya alone. Claims 7 and 9-10 all depend either directly or indirectly from independent claim 1, and therefore include all of the features of the base claim, plus additional features. Applicant further traverses this rejection as follows, because a *prima facie* case of obviousness has not been established.

Section 2143.01 of the MPEP requires, when no extrinsic evidence is made of record, that the cited prior art references themselves must teach or suggest the desirability of making the actual combination proposed by the Examiner. In the present case, however, this requirement has not been met. The only rationale submitted on the record for the proposed combination (page 5, lines 15-19 of the outstanding Office Action) is a statement of the Examiner's own personal opinion, with no citation to any

teaching or suggestion from either of the cited references. For at least this reason, the proposed obviousness combination is deficient on its face under the requirements of Section 2143.01.

The proposed combination is further deficient because the cited references do not support the Examiner's proposed combination. The two head sliders that the Examiner proposes to combine, namely, the slider from Utsunomiya's Fig. 7 with the slider from Nakano's Fig. 15, are not analogous. The Examiner asserts that Nakano's control structures 10c, 10d are analogous to the second guide grooves of the present invention by being *in connection with the rear outflow area 6*, which the Examiner deems analogous to the first guide grooves of the present invention. Utsunomiya, however, fails to show any structure that reasonably corresponds to Nakano's outflow area 6.

The simple combination of Nakano with Utsunomiya would not allow any communication between the control structures 10c, 10d of Nakano with the rear of the slider because Utsunomiya requires the presence of the convex portion 12b between what would be the two cited portions (control structures and rear outflow area) of Nakano. Utsunomiya's convex portion 12b will entirely prevent any communication between the cited portions of Nakano, which would render the proposed combination head slider incapable of reading upon the present invention. Accordingly, the outstanding obviousness rejection of claims 7 and 9-10 is further traversed for at least these reasons.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over "Utsunomiya" in view of Nakano in further view of Utsunomiya (U.S. 6,072,662). As

Applicant is best able to understand this rejection, the Examiner is intentionally citing the same Utsunomiya reference in view of itself. Regardless, this rejection should be withdrawn for several reasons. First, claim 8 indirectly depends from independent claim 1. Second, the proposed combination of Utsunomiya with Nakano is deficient on its face for the several reasons discussed above. Third, none of the cited portions from Fig. 17 of Utsunomiya illustrate a “groove,” as the term would be easily understood by anyone skilled in the art.

As previously discussed, the term “groove” is defined as being “a long, narrow cut in a surface.” (See Webster’s Desk Dictionary, 1996 Ed.). None of the negative pressure portions shown in Fig. 17 of Utsunomiya, however, could meet this plain meaning of the term. Every one of the illustrated negative pressure portions is shaped as either a circle or an oval, and one of ordinary skill in the art would not interpret any one of them, and particularly portion B (cited by the Examiner), as being a “groove.” Accordingly, the rejection should be withdrawn for still these further reasons.

For all of the foregoing reasons, Applicant submits that this Application, including claims 1-10, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

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